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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,805	08/30/2001	Serge Restle	05725.0927	6749
22852	7590	10/30/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SOROUSH, LAYLA	
			ART UNIT	PAPER NUMBER
			1627	
			MAIL DATE	DELIVERY MODE
			10/30/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/890,805

Applicant(s)

RESTLE ET AL.

Examiner

LAYLA SOROUSH

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24, 27-49 and 51-76 is/are pending in the application.
- 4a) Of the above claim(s) 27-33, 38-48, 52-73 and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 34-37, 49, 51, 74 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2009 has been entered.

The rejections are as below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 34-37, 49, 51 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeer (US 5880076 A).

Vermeer exemplifies a Shower Gel comprising Sodium Coconut Isethionate in 5-10 wt%, Sodium Ether Lauryl Sulfate 2-5 wt%, Glycacarbamate, Glycaurea or mixtures thereof (nonionic) 1-45 wt%, Coconutamidopropyl betaine 8-15 wt%, Ethyleneglycol Distearate (nonionic) 4-10 wt%, isopropyl palmitate (hair conditioning agent and emulsifiers/emollients (refatting agents) or dispersants useful in the personal product and detergent compositions) 0.5-1

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wt%, Moisturizer 0.2-1 wt%, Preservative 0.05-0.1 wt%, Sodium Chloride 1-5 wt%, Water and Optional Ingredients to Balance.

Although, Vermeer teaches the hair conditioning agents at about 0% to about 10%, preferably from about 0% to about 8%, even more preferably from about 0% to about 6% by weight of the composition and the emulsifier or emollient are from about 0% to about 10% by weight of the composition, Vermeer fails to teach the specific amount of 1.2% to 8% or 1.5 to 8% of the ester as recited in claims 24 and 51. Further, the Shower Gel of Vermeer comprises an opacifying agent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the dose range of Vermeer's compound by routine experimentation (see 2144.05 11) and to remove the opacifying agent. The motivation to optimize the dose range of the Vermeer's final formulation is because Vermeer teaches the hair condition agents are useful in 0% to about 10%, preferably from about 0% to about 8%, even more preferably from about 0% to about 6% by weight of the composition and the emulsifier or emollient are from about 0% to about 10% by weight of the composition. Hence, adjusting the amounts within the range taught in the prior art is rendered obvious. Additionally, the motivation to remove the opacifying agent of Vermeer comes from the teaching that the suspending agent is used in 0% to about 7%, preferably from about 0% to about 5%, even more preferably from about 0% to about 4% by weight of the composition and the opacifying and pearlescent agents are used in 0% to about 7% by weight of the composition. Moreover, the reference teaches

in an example that "All surfactant systems were added wither as a clear solution or as an opacified mixture." A skilled artisan would have had reasonable expectation of success in achieving a clear personal product composition with optimal conditioning and emulsifying properties.

Response to Arguments

Applicant's arguments filed August 13, 2009 have been fully considered but are not persuasive.

Vermeer discloses that ethylene glycol distearate acts as a suspending, opacifier and pearlescent agent. Applicant argues the skilled artisan would not have reasonable expectation of success in removal of the suspending agents. Further, applicant argues the suspending agent is used to maintain insoluble conditioning agents such as isopropyl palmitate in suspension. The Examiners contention is that the prior art does not require the suspending, opacifying or pearlescent agent of the prior art. The reference clearly states the suspending agent is used in 0% to about 7%, preferably from about 0% to about 5%, even more preferably from about 0% to about 4% by weight of the composition and the opacifying and pearlescent agents are used in 0% to about 7% by weight of the composition. Moreover, the prior art teaches in an example that "All surfactant systems were added wither as a clear solution or as an opacified mixture." Additionally, applicants argument that the suspending agent is used to maintain insoluble conditioning agents such as isopropyl palmitate in suspension is not

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persuasive since there is no evidence of record that 4-10 wt% of Ethylene glycol Distearate is required and acts to suspend 0.5-1 wt% of isopropyl palmitate.

Applicant argues one "skill in the art would not have had a reasonable expectation of success in increasing the amount of insoluble conditioning agent in a composition, as that increase would have been expected to negatively affect the stability of the composition, or require the addition of dispersing or gelling agents to the composition." The argument is not persuasive because the Vermeer reference clearly states that the hair condition agents are useful in about 0% to about 10%, preferably from about 0% to about 8%, even more preferably from about 0% to about 6% by weight of the composition and the emulsifier or emollient are from about 0% to about 10% by weight of the composition. Hence, adjusting the amounts within the range taught in the prior art is rendered obvious.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shengjun Wang/

Primary Examiner, Art Unit 1627